

**REMARKS****I. General**

The issues outstanding in the instant application are as follows:

- The drawings are objected to;
- Claims 1-52 stand rejected under 35 U.S.C. 112, second paragraph;
- Claims 1-2, 4, 6, 7, 12-17, 26, 27, 32, 33, 36, 41-43, 47, 48 and 52 stand rejected under 35 U.S.C. 102(e) as anticipated by Kung et al., U.S. Pat. Pub. No. 2003/0133558 (hereinafter, *Kung '558*);
- Claims 3 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558* in view of *Cell*, U.S. Pat. No. 6,876,647 (hereinafter, *Cell*);
- Claims 4 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558* in view of *Vo et al.*, U.S. Pat. No. 6,795,444 (hereinafter, *Vo*);
- Claims 8 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558* in view of Kung et al., U.S. Pat. No. 6,816,469 (hereinafter, *Kung '469*);
- Claims 9, 21, 35 and 49 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558* in view of Kung et al., U.S. Pat. No. 6,687,360 (hereinafter, *Kung '360*);
- Claims 10 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558* and *Cell*, and further in view of Pandharipande, U.S. Pat. No. 6,529, 500 ( hereinafter, *Pandharipande*);
- Claims 23 and 27-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558* and *Cell*, and further in view of Weitz, U.S. Pat. No. 6,445,682 ( hereinafter *Weitz*);

- Claim 30 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558*, *Cell*, and *Weitz*, and further in view of *Pogossiants et al.*, U.S. Pat. Pub. No. 2001/0028649 (hereinafter, *Pogossiants*).
- Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558* and *Kung '469*, and further in view of *Minert et al.*, U.S. Pat. Pub. No. 2002/0141386 ( hereinafter, *Minert*);
- Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558*, *Kung '469* and *Minert*, and in further view of *Pogossiants*;
- Claims 24 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558*, *Kung '469*, and *Minert*, and further in view of *Weitz*;
- Claims 34, 37, 39, 44, 45 and 50 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558*, in view of *Gainsboro*, U.S. Pat. No. 6,611,583 (hereinafter, *Gainsboro*);
- Claims 38, 39 and 51 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558*, in view of *Peel et al.*, U.S. Pat. No. 5,907,602 (hereinafter *Peel*);
- Claims 40 and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558*, in view of *Ziegler et al.*, U.S. Pat. Pub. No. 2003/0023714 (hereinafter, *Zeigler*); and
- Claim 31 stands objected to as being dependent upon a rejected base claim.

As a preliminary matter Applicant wishes to express gratitude for the indication of allowability of claim 31. However, Applicant hereby traverses the outstanding rejections of the remaining claims, and requests reconsideration and withdrawal of the outstanding rejections in light of the amendments and remarks contained herein. Claims 1-52 remain pending in this application.

## **II. Objections to the Drawings**

The Office Action objects to the drawing under 37 C.F.R. § 1.83(a) on the premise that the drawings must show every feature of the claimed invention specified in the claims, and that structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. The Applicant respectfully submits that it is not necessary that every detail of an invention be illustrated by the drawing, unless the form of the device is the principal of the invention, *Sterns v. Tinker & Rasor*, 116 USPQ 222, 227 (1958). Regardless, Applicant addresses the specific objections to the drawing as follows.

The Office Action indicates that (one or more of) claims 1, 12, 26, 32 and 43 recite “voice over IP network” and notes that such a voice over IP network is not literally shown in the drawings. The Office Action also alleges that the drawings fail to show the VoIP network, referred to on page 2, lines 20-21, and page 3, line 8 of the specification. Applicant respectfully asserts that one of ordinary skill in the art would appreciate, particularly in light of the teachings of the specification, that the WAN (Wide Area Network) illustrated in various ones of the Figures can be used as a VoIP network, in addition to being employed for other network functions. However, in the interest of clarification and in order to advance prosecution of the present application, Applicant proposes amending FIGURE 1 to indicate network 18, as merely a “network,” as shown in the accompanying replacement drawing sheet 1/5.

The Office Action indicates that (one or more of) claims 1, 12, 26, 32 and 43 recite “switching means” and alleges that this feature is not shown in the drawing. However, Applicant respectfully points out that at least FIGURE 1 of the present application shows “switching” box 20, as part of computer 12, which page 4, lines 3-5, of the present specification describes as follows: “A programmable computer 12 at the site is provided for switching, accessing, routing, timing, billing and the control of the telephones 10 at the site” (emphasis added).

The Office Action indicates that (one or more of) claims 1, 12, 26, 32 and 43 recite “Ethernet network interface” and alleges that this feature is not shown in drawings.

Applicant respectfully directs the Examiner's attention to FIGURE 6B which clearly shows "Ethernet Network Interface" 60.

### **III. Rejections under 35 U.S.C. §112, second paragraph**

Claims 1-52 stand rejected under 35 U.S.C. 112, second paragraph as being indefinite.

The Office Action indicates that claim 1 recites the limitation "the control of said telephones" in line 4 and that there is no antecedent basis for this limitation in the claim. Without addressing the veracity of this rejection, claim 1 has been amended to remove the word "the" from the objectionable phrase. The Office Action also points out that claim 1 recites the limitation "said telephone instruments" in line 8, and alleges that there is no antecedent basis for this limitation in the claim. In response, the phrase "telephone instruments" has been replaced with the word "telephones."

The Office Action also points out that claim 2 recites the limitation "the programming" in line 1, and alleges that there is insufficient antecedent basis for this limitation in the claim. Again, without conceding the veracity of this rejection, claim 2 has been amended to remove the word "the" from the objectionable phrase.

The Office Action goes on to state: "There are similar problems that exist in rest of the claims. All of these should be corrected." Whereas this is a rejection of the claims, Applicant respectfully points out that the rejection of at least claims 3-52, under 35 U.S.C. §112, second paragraph, does not comport with Office policy. Specifically, the Examiner is directed that "[i]n accordance with the patent statute, 'Whenever, on examination, any claim for a patent is rejected, or any objection . . . made', notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given," M.P.E.P. § 707. As such the Examiner has not clearly articulated the § 112, second paragraph, rejections of at least claims 3-52 so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity as required by M.P.E.P. §706. Applicant therefore requests that the Examiner set forth the specific objectionable language of claims 3-52 in a non-final Office Action in order that Applicant

may have a full and fair opportunity to explore the patentability of these claims.

Nevertheless, using the Examiner's specified objections to language appearing in claims 1 and 2 as a guide, Applicant has amended claims 4, 5, 6, 12, 13, 14, 16, 17, 18, 19, 21, 22, 25, 26 and 30 in an attempt address the "blanket" rejection advanced by the Office Action.

Each element of indefiniteness cited by the Office Action has been addressed with a corresponding amendment or argument. Therefore, Applicant respectfully requests the rejection of claims 1-52 under 35 U.S.C. §112, second paragraph be withdrawn.

#### **IV. Inconsistencies in Claim Rejections**

The Office Action, in point 7 on page 4 and on page 6, indicates that that claim 4 is rejected under 35 U.S.C. §102(e) as anticipated by *Kung* '558. However, in point 10 on page 8, the Office Action admits that *Kung* '558 fails to teach or suggest:

a plurality of said given sites (270 and 272); at least one programmable control computer (MCU 280) at each site; said sites being interconnected over said VoIP network (108), as recited by claim 4

The Office Action applies FIGURE 2A of *Vo* in an attempt to cure this deficiency.

The Office Action, in point 7 on page 4 and on page 6, indicates that that claim 27 is rejected under 35 U.S.C. §102(e) as anticipated by *Kung* '558. However, in point 14 on page 11, the Office Action admits that the combination of *Kung* '558 and *Cell* fail to teach or suggest "VoIP gateway includes voice compression and packetization," which the Office Action attempts to address by introducing *Weitz*.

M.P.E.P. § 706 directs the Examiner to "clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." Applicant therefore requests that the Examiner clarify the grounds for rejection of at least claims 4 and 27 in a non-final Office Action, so that Applicant may have a full and fair opportunity to explore the patentability of these claims.

**V. Rejection(s) under 35 U.S.C. §102(e)**

Claims 1-2, 4, 6, 7, 12-17, 26, 27, 32, 33, 36, 41-43, 47, 48 and 52 stand rejected under 35 U.S.C. 102(e) as anticipated by *Kung* '558. Applicant has amended claims 1, 12 and 26 to clarify the meaning of “control” as used in the body of these claims. These amendments are cosmetic in nature, making the claims read more clearly. Therefore, basis for these amendment exists in the claims themselves, as filed. Thus, no new matter has been added. Applicant respectfully traverses these rejections at least for the reasons advanced below.

**The recited reference does not teach all claimed limitations.**

It is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a reference to be anticipatory under 35 U.S.C. §102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejections do not satisfy one or more of these requirements, as detailed below.

**A. Claims 1, 2, 4, 6, 7, 12, 14 through 17, 26, 27**

Independent claim 1, as amended, recites: “a programmable control computer for... controlling usage of said telephones.” Similarly independent claim 12 recites “a programmable control system for performing the functions of ... controlling use of said telephones.” Claim 26, as amended, recites: “A control computer ...comprising: programmable means for controlling usage of said telephones.” *Kung* '558 does not disclose at least these limitations.

Prior to amendment the Office Action cited paragraphs 0027 and 0055 of *Kung* '558 as disclosing this limitation. However, Applicant notes that paragraph 0027 of *Kung* '558 only describes various interfaces provided by broadband residential gateway 300 and paragraph 0055 of *Kung* '558 only describes how a call manager sets-up and tears-down

calls. Nothing *Kung* '558 teaches controlling usage, or use, of telephones such as employed in the claimed controlled public telephone communications system.

Therefore, *Kung* '558 does not teach all limitations of independent claims 1, 12 and 26. Hence, Applicant respectfully asserts that at least for the above reasons claims 1, 12 and 26 are patentable over the 35 U.S.C. § 102 rejections of record. Furthermore, there are great differences between claim 1 and the art of record, claim 12 and the art of record, and claim 26 and the art of record. A person of ordinary skill in the art considering the prior art would not find these differences obvious.

Claims 2, 4, 6 and 7 each depend directly from independent claim 1, and thus each of claims 2, 4, 6 and 7 inherit all limitations of claim 1. Each of claims 14 through 17 ultimately depend from independent claim 12, and thus each of claims 14 through 17 inherit all limitations of claim 12. Claim 27 depends directly from claim 26 and thereby inherits all limitations of claim 26. Thus, for at least the reasons advanced above in addressing the anticipation rejections of claims 1, 12 and 26, each of claims 2, 4, 6, 7, 14 through 17 and 27 set forth features and limitations not recited by *Kung* '558. Therefore, Applicant respectfully asserts that claims 2, 4, 6, 7, 14 through 17 and 27 are also patentable over the 35 U.S.C. § 102 rejection of record.

Furthermore, various ones of claims 2, 4, 6, 7, 14 through 17 and 27 recite limitations not taught by *Kung* '558. For example, claim 2 recites "programming for said control computer is distributed to remote locations over said VoIP network." The Office Action cites distributed processing controller 306 of broadband residential gateway 300 as described in paragraph 0081 of *Kung* '558 as teaching this limitation. However, Applicant respectfully points out that paragraph 0081 of *Kung* '558 describes distributed processing controller 306 of broadband residential gateway 300 as controlling functions within the gateway, such as telephony processing, data processing, video processing, auxiliary processing, IP processing, and/or an operations administration maintenance and provisioning interconnected through one or more busses. Thus, the distributed processing controller 306 of broadband residential gateway 300 *Kung* '558, does not teach programming distributed to remote locations over a VoIP network, as all of the processing discussed in paragraph 0081 of *Kung* '558 is contained

with the broadband residential gateway 300. For at least this additional reason, claim 2 is further patentable over the anticipation rejection of record.

## **B. Claims 32-42**

The preamble of independent claim 32 recites: “A call processing system for use in processing calls associated with a prison facility.” M.P.E.P. § 2111.02, citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) provides: “Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.” Additionally, the body of claim 32 recites: “a plurality of telephone terminals disposed at said prison facility.” The preamble of independent claim 43 recites: “A method for providing prison facility call processing.” The body of claim 43 recites “coupling ... a centralized system providing call control functions to a prison telephone system having a voice over Internet protocol (VoIP) gateway” and “interfacing a telephone terminal of said prison telephone system coupled to said VoIP gateway with a public switched telephone network.” The Office Action fails to address these limitations and *Kung '558* does not disclose these limitations.

The Office Action fails to address at least the following emphasized limitations of claim 32 “[a] call processing system for use in processing calls associated with a prison facility” and “a plurality of telephone terminals disposed at said prison facility”. Similarly the Office Action fails to address at least the following emphasized limitations of claim 42: “[a] method for providing prison facility call processing,” “coupling ... a centralized system providing call control functions to a prison telephone system having a voice over Internet protocol (VoIP) gateway,” and “interfacing a telephone terminal of said prison telephone system coupled to said VoIP gateway with a public switched telephone network.”

Accordingly, Applicant respectfully points out that the rejections of independent claims 32 and 43, as well as the rejections of dependent claims 33, 36, 41, 42, 47, 48 and 52, do not comport with Office policy. Specifically, the Examiner is directed that “[i]n accordance with the patent statute, ‘Whenever, on examination, any claim for a patent is rejected , or any objection . . . made’, notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given,” M.P.E.P. § 707. As such the



Examiner has not “clearly articulate[d] any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity,” M.P.E.P. §706. Applicant therefore requests that the Examiner set forth the grounds for rejection, with respect to at least the above emphasized limitations of independent claims 32 and 43, in a non-final Office Action, so that Applicant may have a full and fair opportunity to explore the patentability of claims 32, 33, 36, 41 -43, 47, 48 and 52.

Regardless, *Kung* ‘558 is silent concerning processing calls associated with a prison facility, disposing telephone terminals at a prison facility, a prison telephone system and/or the like. The system of *Kung* ‘558 deals with providing broadband services to customers. With attention directed to paragraph 0027, Applicant notes that *Kung* ‘558 specifically discusses customer premises equipment including broadband residential gateway 300. Since *Kung* ‘558 is silent concerning prison related call control, prison telephone systems, or the like, and *Kung* ‘558 specifically speaks to residential systems, Applicant respectfully asserts that *Kung* ‘558 cannot be read as teaching (or suggesting) processing calls associated with a prison facility, disposing telephone terminals at a prison facility, a prison telephone system and/or the like.

Additionally, claim 32 recites “a processor-based system ... providing call control for controlling communications between said plurality of telephone terminals and said user terminals external to said prison facility.” Similarly, as noted above, claim 43 recites: “a centralized system providing call control functions to a prison telephone system.” *Kung* ‘558 does not disclose these limitations either. As understood by Applicant, it appears that the Office Action has cited paragraphs 0027 and 0055 of *Kung* ‘558 as disclosing these limitations. However, Applicant notes that paragraph 0027 of *Kung* ‘558 only describes various interfaces provided by broadband residential gateway 300 and paragraph 0055 of *Kung* ‘558 only describes how a call manager sets-up and tears-down calls. Nothing *Kung* ‘558 teaches controlling communication from terminals disposed in a prison.

Therefore, *Kung* ‘558 does not teach all limitations of independent claims 32 and 43. Hence, Applicant respectfully asserts that at least for the above reasons claims 32 and 43 are patentable over the 35 U.S.C. § 102 rejections of record. Furthermore, there are great

differences between claims 32 and 43 and the art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious.

Claims 33, 36, 41 and 42 each depend directly from independent claim 32, and thus each of claims 33, 36, 41 and 42 inherit all limitations of claim 32. Claims 47, 48 and 52 each depend directly from independent claim 43, and thus each of claims 47, 48 and 52 inherit all limitations of claim 43. Thus, for at least the reasons advanced above in addressing the anticipation rejections of claims 32 and 43, each of claims 33, 36, 41, 47, 48 and 52 set forth features and limitations not recited by *Kung* '558. Therefore, Applicant respectfully asserts that claims 33, 36, 41, 47, 48 and 52 are also patentable over the 35 U.S.C. § 102 rejections of record.

Furthermore, various ones of claims 33, 36, 41, 47, 48 and 52 recite limitations not taught by *Kung* '558. For example, claim 52 recites "centralized system provides call monitoring with respect to said call." The Office Action cites distributed processing controller 306 of broadband residential gateway 300 as described in paragraph 0081 of *Kung* '558 as teaching this limitation. As pointed out above paragraph 0081 of *Kung* '558 describes distributed processing controller 306 of broadband residential gateway 300 as controlling functions within the gateway. Paragraph 0081 is silent concerning any sort of call monitoring. For at least this additional reason, claim 52 is further patentable over the anticipation rejection of record.

## **VI. Rejections under 35 U.S.C. §103(a)**

As noted above, claims 3 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung* '558 in view of *Cell*. Claims 4 and 5 stand rejected as being unpatentable over *Kung* '558 in view of *Vo*. Claims 8 and 18 stand rejected as being unpatentable over *Kung* '558 in view of *Kung* '469. Claims 9, 21, 35 and 49 stand rejected as being unpatentable over *Kung* '558 in view of *Kung* '360. Claims 10 and 11 stand rejected as being unpatentable over *Kung* '558 and *Cell*, and further, in view of *Pandharipande*. Claims 23 and 27-29 stand rejected as being unpatentable over *Kung* '558 and *Cell*, and further in view of *Weitz*. Claim 30 stands rejected as being unpatentable over *Kung* '558, *Cell*, and *Weitz*, and further, in view of *Pogossiants*. Claim 19 stands rejected under 35 U.S.C. 103(a)

as being unpatentable over *Kung '558* and *Kung '469*, and further in view of *Minert*. Claim 20 stands rejected as being unpatentable over *Kung '558*, *Kung '469* and *Minert*, and in further view of *Pogossiants*. Claims 24 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558*, *Kung '469*, and *Minert*, and further in view of *Weitz*. Claims 34, 37, 39, 44, 45 and 50 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung '558*, in view of *Gainsboro*. Claims 38, 39 and 51 stand rejected as being unpatentable over *Kung '558*, in view of *Peel*. Claims 40 and 46 stand rejected as being unpatentable over *Kung '558*, in view of *Zeigler*. Applicant respectfully traverses these rejections for at least the following reasons.

**A Prima Facie case of obviousness has not been established.**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding the second criterion, Applicant asserts that the obviousness rejections do not satisfy the first and third criteria.

**A. The recited combination does not teach or suggest all claimed limitations.**

The Office Action admits that *Kung '558* does not teach various limitations of claims 3-5, 8-11, 18-25, 27-30, 34, 35, 37-40, 44-46, 49-51. The Office Action attempts to cure these deficiencies by introducing various ones of, or combinations of, *Cell*, *Vo*, *Kung '469*, *Kung '360*, *Pandharipande*, *Weitz*, *Pogossiants*, *Minert*, *Gainsboro* and/or *Zeigler*. However, the combinations, as presented, do not teach or suggest all limitations of the claimed invention.

Claims 3-5 and 8-11 ultimately depend from independent claim 1, and thereby inherit all limitations of claim 1. Claims 18-25 ultimately depend from independent claim 12, and thereby inherit all limitations of claim 12. Claims 27-30 ultimately depend from independent claim 26, and thereby inherit all limitations of claim 26. Claims 34, 35 and 37-40 ultimately

depend from independent claim 32, and thereby inherit all limitations of claim 32. Claims 44-46 and 49-51 ultimately depend from independent claim 43, and thereby inherit all limitations of claim 43. As pointed out above in addressing the anticipation rejections of independent claims 1, 12, 26, 32 and 43, *Kung '558* fails to teach or suggest various limitations recited by independent claims 1, 12, 26, 32 and 43. The secondary references cited by the Office Action (*Cell, Vo, Kung '469, Kung '360, Pandharipande, Weitz, Pogossiants, Minert, Gainsboro* and/or *Zeigler*) are not relied upon in the Office Action as disclosing the limitations pointed out above as missing from *Kung '558*. Therefore, the various combinations of references that rely on *Kung '558* as teaching the limitations of independent claims 1, 12, 26, 32 and 43 do not teach all limitations of claims 3-5, 8-11, 18-25, 27-30, 34, 35, 37-40, 44-46, 49-51. Thus, Applicant respectfully asserts that for at least the this reason claims 3-5, 8-11, 18-25, 27-30, 34, 35, 37-40, 44-46, 49-51 are patentable over the 35 U.S.C. § 103(a) rejections of record.

Furthermore, various ones of claims 3-5, 8-11, 18-25, 27-30, 34, 35, 37-40, 44-46, 49-51 recite limitations not taught by *Kung '558* and/or the other cited references. For example, claims 9 and 21 each recite: “authorizing stored permitted telephone usage associated with individual PIN numbers.” The Office Action cites column 29, lines 45-60 of *Kung '360* as teaching these limitations. However, this portion of *Kung '360* only teaches that a PIN is used to prompt a system to forward calls to the user’s number to a new location. Thus at least this portion of *Kung '360* fails to teach or suggest “authorizing stored permitted telephone usage associated with individual PIN numbers” as recited by claims 9 and 21. For at least these additional reasons, claims 9 and 21 are further patentable over the obviousness rejections of record.

As a further example, claim 20 recites “third party call detection is performed between said second VoIP gateway and said public switched telephone network.” Similarly claim 30 recites a “third party call detection system being disposed between said second VoIP gateway and said public switched telephone network.” The Office Action cites public switched telephone network 617, of FIGURE 6 and paragraphs 0025 and 0090 of *Pogossiants* as disclosing these limitations. However. The cited portion of *Pogossiants* only discusses a transaction server used to route calls. These portions of *Pogossiants* are silent

concerning third party call detection or the like. Therefore, Applicant respectfully asserts that the combination of *Kung '558*, *Kung '469*, *Minert*, and *Pogossiants* fails to teach or suggest “third party call detection is performed between said second VoIP gateway and said public switched telephone network” as recited by claim 20. Similarly, Applicant respectfully asserts that the combination of *Kung '558*, *Cell*, *Weitz*, and *Pogossiants* fails to teach or suggest “third party call detection system being disposed between said second VoIP gateway and said public switched telephone network” as recited by claim 30. For at least these additional reasons, claims 20 and 30 are further patentable over the obviousness rejections of record.

**B. The Office Action does not provide the requisite motivation.**

As discussed above, the Office Action admits that *Kung '558* does not teach various limitations of claims 3-5, 8-11, 18-25, 27-30, 34, 35, 37-40, 44-46, 49-51. The Office Action attempts to cure these deficiencies by introducing various ones of, or combinations of, *Cell*, *Vo*, *Kung '469*, *Kung '360*, *Pandharipande*, *Weitz*, *Pogossiants*, *Minert*, *Gainsboro* and/or *Zeigler*. As an example of the various statements of motivation presented for making the various combination, the motivation presented for combining *Kung '558* and *Cell* to reach claims 3 and 22, was presented as follows:

The motivation for using VoIP gateway in IP central station is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. Language such as that presented as motivation to combine *Kung '558* and *Cell* is, at best, merely a statement that the reference can be combined, and does not state any desirability for making the combination. Further, this language is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Additionally, the stated motivation appears to only be a restatement of the function of a VoIP gateway and thus fails to indicate any desirability for making the combination. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01.

Similar motivation is provided for combining *Kung '558* and *Vo* to reach claims 4 and 5; for combining *Kung '558* and *Kung '469* to reach claims 8 and 18; for combining *Kung '558* and *Kung '360* to reach claims 9, 21, 35 and 49; for combining *Kung '558*, *Cell*, and *Pandharipande* to reach claims 10 and 11, for combining *Kung '558*, *Cell*, and *Weitz* to reach claims 23 and 27-29; and for combining *Kung '558*, *Cell*, *Weitz*, and *Pogossiants* to reach claim 30.

The motivation presented to combine *Kung '558*, *Kung '469*, and *Minert* to reach claim 19, as well as the motivation presented to combine *Kung '558*, *Kung '469*, *Minert*, and *Pogossiants* to reach claim 20 was the following: "The motivation for using VoIP is to establish a VoIP telephoning calling." This statement is clearly a circular statement and fails to provide any desirability for making the combination.

The same motivation is presented for combining *Kung '558*, *Kung '469*, *Minert*, and *Weitz* to reach claims 24 and 25; for combining *Kung '558* and *Gainsboro* to reach claims. 34, 37, 39, 44, 45 and 50; for combining *Kung '558* and *Peel* to reach claims. Claims 38, 39 and 51; and for combining *Kung '558* and *Zeigler* to reach claims 40 and 46.

For at least the foregoing reasons the motivation provided by the Office Action is improper and insufficient. The motivation must establish the desirability for making the combination. No valid suggestion has been made as to why a combination of *Kung '558* and any one, or more, of *Cell*, *Vo*, *Kung '469*, *Kung '360*, *Pandharipande*, *Weitz*, *Pogossiants*, *Minert*, *Gainsboro* and/or *Zeigler* is desirable. Therefore, the rejection of claims 3-5, 8-11, 18-25, 27-30, 34, 35, 37-40, 44-46, 49-51 should be withdrawn.

## **VII. Conclusion**

Again, Applicant wishes to thank the Examiner for the indication of allowability of claim 31. However, for at least the reasons given above, Applicant submits that the remaining pending claims distinguish over the prior art under 35 U.S.C. §§ 102 and 103 and

meet the requirements of 35 U.S.C. §112. Accordingly, Applicant submits that this application is in condition for allowance.

Applicants believe that a fee of \$225.00 is due with this response. However, if there is any further amount due, please charge Deposit Account No. 06-2380, under Order No. 63134/P026US/10400589 from which the undersigned is authorized to draw.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

Dated: September 19, 2005

Respectfully submitted,

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